UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
3627	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	Applicant(s)
Office Action Summary	10/051,282	FELKEY ET AL.
	Examiner	Art Unit	
	MARISSA THEIN	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 January 2010*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15,17,21-23,27-30,32-36,40 and 41* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15,17, 21-23,27-30,32-36,40 and 41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

Applicants' "Request for Continued Examination" filed on January 26, 2010 has been considered.

Applicants' remark by virtue of amendment to claims 1-15, 17, 21-23 and 40-41 has <u>not</u> overcome the Examiner's rejection under 35 USC § 101.

Claims 1, 12, 21, 27, 35, 36 and 40 are amended. Claims 37-39 are withdrawn. Claims 1-15, 17, 21-23, 27-30, 32-36, 40 and 41 remain pending in this application.

Claim Objections

Claims 11, 17, and 23 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Examiner suggest in writing the claims in independent form as a "computer-readable media ...".

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 12, 21, 27, 35, 36, and 40 have been amended to include the limitation "a customer who is not yet a subscriber" which appears to be new matter. No support for this limitation was found in the Applicant's disclosure. The limitation also appears to be a negative limitation. MPEP 2173.05(i) states: "Any negative limitation or

exclusionary proviso <u>must have basis in the original disclosure</u>. If alternative elements

are positively recited in the specification, they may be explicitly excluded in the claims.

… <u>The mere absence of a positive recitation is not basis for an exclusion</u>. Any claim

containing a negative limitation, which does not have basis in the original disclosure,

should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

written description requirement."

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15, 17, 21-23 and 40-41 are rejected under 35 U.S.C. 101 based on

Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to

examiners is that a § 101 process must in accordance with the M-or-T test, the claimed

process must: (1) be tied to a particular machine or apparatus (machine implemented);

or (2) particularly transform a particular article to a different state or thing. In re Bilski et

al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981);

Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70

(1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

A method claim that does not require machine implementation or does not cause

a transformation will fail the test and should be rejected under § 101. However, the

mere presence of a machine tie or transformation is not sufficient to pass the test.

When a machine tie or transformation has been identified, it must be further

determined that the tie is to a particular machine or the particular transformation is of a

particular article. Additionally, the particular machine tie or particular transformation

must meet two corollaries to pass the test for subject matter eligibility. First, the use of

the particular machine or transformation of the particular article must impose a

meaningful limit on the claim's scope. So, a machine tie in only a field-of-use limitation

would not be sufficient. Second, the use of the particular machine or the transformation

of the particular article must involve more than insignificant "extra-solution" activity. If

the machine or transformation is only present in a field-of-use limitation or in a step that

is only insignificant "extra-solution" activity, the claim fails the M-or-T test, despite the

presence of a machine or a transformation in the claim.

Here, applicant's method steps, fail the first prong of the new Federal Circuit

decision since they are not tied to a particular machine or apparatus. Thus, the claims

are non-statutory. Examiner recommends in amending the claim to include a

"computing device", but include the "computing device" to a meaningful limit or

significant activity.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-26, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,085,171 to Leonard in view of U.S. Patent No. 6,965,868 to Bednarck.

Regarding claims 1, 11, and 35, Leonard discloses a computer –implemented method, apparatus and computer-readable media storing computer-executable instructions for procuring telecommunications offering remotely comprising: receiving a procurement inquiry from a customer application, the procurement inquiry specifying a selected telecommunications offering from a plurality of offerings including voice service, data access service and mobile telecommunications offerings (col. 4, lines 1-9; col. 3, lines 37-56; col. 4, lines 49-54; Figure 10; col. 13, lines 25-26), the procurement inquiry being directed at least to one or more telecommunication services to which a customer who is not yet a subscriber is considering a subscription (col. 3, lines 57-63); generating procurement data in response to the procurement inquiry (col. 2, lines 4-20; Figure 12; col. 13, lines 32-45); and transmitting the procurement data to the customer application (col. 8, lines 36-41).

However, Leonard does not explicitly disclose providing an option for accessing a network consultant via instant messaging. Leonard discloses a method of ordering a change of communication service (col. 1, lines 46-50). Customers communicate and/or receive voice, video, and/or data signals form communication devices. Communication devices can be cellular telephones, computers, Internet appliances, personal digital assistants or any other devices for communicating and/or receiving voice, video, and/or data signals. (Col. 3, lines 46-56)

Bednarck, on the other hand, teaches providing an option for accessing a

network consultant via instant messaging (col. 10, lines 50-53; col. 11, lines 64-66; col.

14, lines 46-49).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention was made to modify the method of Leonard, to include providing

an option for accessing a network consultant via instant messaging, as taught by

Bednarck, in order to engage in real time dialogue (Bednarck, col. 11, lines 64-65) and

provide intensive interaction and customized information with the customer (Bednarck,

col. 14, lines 48-49).

Regarding claims 2-4, 7, 8-10, Leonard discloses the procurement data of pre-

sale, ordering and post-sale data (col. 3, lines 57-63; col. 12, lines 23-44; col. 12, line 66

- col. 13, line 24); transmitting the pre-sale data comprising value added content which

includes at least one of data for matching the selected telecommunication offering with

needs of a customer, data for qualifying a customer for the selected telecommunication

offering, data for an on-line demonstration of a process for procuring the selected

telecommunication offering, data for answers to technical questions (col. 3, lines 57-63;

col. 12, lines 23-44; col. 12, line 66 - col. 13, line 24); transmitting post-sale data

comprising value added content, the value added content including at least one of data

for providing access to exiting orders, data for providing electronic billing, data for

sending of a page, data for scheduling of a conference call, data for on-line directory

assistance, or tailored data for on one of a telecommunication ordered or a related

telecommunication offerings (col. 3, lines 57-63; col. 12, lines 23-44; col. 12, line 66 -

col. 13, line 24); providing the voice service offering to include calling package, a long

distance, a toll free, a conferencing and a calling card telecommunication offering (col.

4, lines 49-54; col. 12, line 66 - col. 13, line 24); providing the data access service (col.

4, lines 49-54; col. 12, line 66 - col. 13, line 24); providing the mobile

telecommunication offerings (col. 3, lines 37-43; col. 4, lines 49-54; col. 12, line 66 - col.

13, line 24); and graphical user interface (Figures 6-11; col. 10, lines 37-39).

Regarding claim 5-6, Leonard discloses order entry data; order tracking and

order status data (col. 2, lines 5-20)

Regarding claims 12, 14, 17, and 36, Leonard discloses a computer-

implemented method, apparatus and a computer-readable media storing computer-

executable instructions for servicing telecommunication offerings remotely comprising:

receiving an inquiry from a customer application, the inquiry specifying search criteria

with respect to an order for one of a plurality of telecommunication offering including

voice service, data access service and mobile telecommunication service (col. 10, lines

4-36), the inquiry being directed at least to one or more telecommunication services to

which a customer who is not yet a subscriber is considering a subscription (col. 3, lines

57-63), a customer agent assigned for servicing telecommunication offering order, (col.

8, lines 23-49); generating response to the service inquiry and pertaining to the search

criteria (col. 2, lines 4-20; Figure 12; col. 13, lines 32-45); and transmitting the response

data to the customer application (col. 8, lines 36-41).

However, Leonard does not explicitly disclose instant messaging. Leonard

discloses a method of ordering a change of communication service (col. 1, lines 46-50).

Customers communicate and/or receive voice, video, and/or data signals form

communication devices. Communication devices can be cellular telephones,

computers, Internet appliances, personal digital assistants or any other devices for

communicating and/or receiving voice, video, and/or data signals. (Col. 3, lines 46-56)

Bednarck, on the other hand, teaches instant messaging (col. 10, lines 50-53;

col. 11, lines 64-66; col. 14, lines 46-49).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention was made to modify the method of Leonard, to include instant

messaging, as taught by Bednarck, in order to engage in real time dialogue (Bednarck,

col. 11, lines 64-65) and provide intensive interaction and customized information with

the customer (Bednarck, col. 14, lines 48-49).

Regarding claims 13 and 15, Leonard discloses the response data includes at

least on of pre-sale, ordering, and post-sale data (col. 3, lines 57-63; col. 12, lines 23-

44; col. 12, line 66 - col. 13, line 24); and post sale data (col. 3, lines 57-63; col. 12,

lines 23-44; col. 12, line 66 - col. 13, line 24).

Regarding claims 21-23, Leonard discloses a computer-implemented method

and computer-readable media storing computer-executable instructions for procuring

telecommunications offering remotely comprising: submitting an inquiry, specifying a

selected telecommunications offering among a voice, data access and mobile

telecommunications offerings (col. 4, lines 1-9; col. 3, lines 37-56; col. 4, lines 49-54;

Figure 10; col. 13, lines 25-26), the inquiry being directed at least to one or more

telecommunication services to which a customer who is not yet a subscriber is

considering a subscription (col. 3, lines 57-63); receiving procurement data (col. 2, lines 4-20; Figure 12; col. 13, lines 32-45) wherein the procurement data is generated in response to the and pertains to he selected telecommunication offering (col. 2, lines 4-20; Figure 12; col. 13, lines 32-45). Furthermore, Leonard discloses a graphical user interface (Figures 6-11).

However, Leonard does not explicitly disclose instant messaging. Leonard discloses a method of ordering a change of communication service (col. 1, lines 46-50). Customers communicate and/or receive voice, video, and/or data signals form communication devices. Communication devices can be cellular telephones, computers, Internet appliances, personal digital assistants or any other devices for communicating and/or receiving voice, video, and/or data signals. (Col. 3, lines 46-56)

Bednarck, on the other hand, teaches instant messaging (col. 10, lines 50-53; col. 11, lines 64-66; col. 14, lines 46-49).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Leonard, to include instant messaging, as taught by Bednarck, in order to engage in real time dialogue (Bednarck, col. 11, lines 64-65) and provide intensive interaction and customized information with the customer (Bednarck, col. 14, lines 48-49).

Claims 27-30 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,085,171 to Leonard in view of U.S. Patent No. 6,965,868 to Bednarck and further in view of U.S. Patent No. 6,098,108 to Sridhar et al. Leonard substantially disclose the claimed invention, however, Leonard does not

disclose instant messaging; and a customer browser loaded on a customer client computer; a back office browser loaded on a back office client computer; the server program communicate according to a communication protocol architecture that includes a web layer and application layer; a database layer; a site intelligence server; and the development, staging and production system. Leonard discloses a method of ordering a change of communication service (col. 1, lines 46-50). Customers communicate and/or receive voice, video, and/or data signals form communication devices. Communication devices can be cellular telephones, computers, Internet appliances, personal digital assistants or any other devices for communicating and/or receiving voice, video, and/or data signals. (Col. 3, lines 46-56)

Bednarck, on the other hand, teaches instant messaging (col. 10, lines 50-53; col. 11, lines 64-66; col. 14, lines 46-49).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Leonard, to include instant messaging, as taught by Bednarck, in order to engage in real time dialogue (Bednarck, col. 11, lines 64-65) and provide intensive interaction and customized information with the customer (Bednarck, col. 14, lines 48-49).

Furthermore, Leonard and Bednarck do not disclose a customer browser loaded on a customer client computer; a back office browser loaded on a back office client computer; the server program communicate according to a communication protocol architecture that includes a web layer and application layer; a database layer; a site intelligence server; and the development, staging and production system.

Sridhar, on the other hand, teaches a customer browser loaded on a customer

client computer; a back office browser loaded on a back office client computer; the

server program communicate according to a communication protocol architecture that

includes a web layer and application layer; a database layer; and a site intelligence

server (Figure 6; Figure 9; Figure 15; Figure 22; col. 5, lines 7-25; col. 9, lines 44-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention was made to modify the system of Leonard and Bednarck, to

include a customer browser loaded on a customer client computer; a back office

browser loaded on a back office client computer; the server program communicate

according to a communication protocol architecture that includes a web layer and

application layer; a database layer; a site intelligence server; and the development,

staging and production system, as taught by Sridhar, in order to provide enhanced

communication between client and server computers coupled through the Internet

(Sridhar, col. 1, lines 13-15).

Claims 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent No. 6,085,171 to Leonard et al. in view of U.S. Patent No.

6,788,949 to Bansal.

Leonard discloses a method comprising: providing a plurality of options to

communicate with a consultant during provisioning (col. 1, line 1; Figure 5; col. 3, lines

47-56), the provisioning including at least an inquiry being directed at least to one or

more telecommunication services to which a customer who is not yet a subscriber is

considering a subscription (col. 3, lines 57-63); receiving input from the customer

application, the input specifying one or more selections of a plurality of

telecommunications products (Figure 10); determining whether the selection is valid

during the provisioning (Figure 12; Figure 13A); and generating an order for the

selection based on the determining step (Figure 12; Figure 13A).

However, Leonard does not explicitly disclose instant messaging and on-line

shared white-boarding; and web interface. Leonard discloses a method of ordering a

change of communication service (col. 1, lines 46-50). Customers communicate and/or

receive voice, video, and/or data signals form communication devices. Communication

devices can be cellular telephones, computers, Internet appliances, personal digital

assistants or any other devices for communicating and/or receiving voice, video, and/or

data signals. (Col. 3, lines 46-56) Clients 10 couple to client server 90 using links 20,

network 30, and link 40. Network 30 could be the Internet, a wide area network (WAN),

a private or public switched or dedicated network, or any other type of communication

network for transferring data. (Col. 3, lines 9-13)

Bansal, on the other hand, teaches instant messaging and on-line shared white-

boarding, and web interface (col. 1, lines 30-41).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention was made to modify the method of Leonard, to include instant

messaging and on-line shared white-boarding and web base interface, as taught by

Bansal, in order to provide a chat session that allows to enter and send messages

simultaneously (Bansal, col. 1, lines 22-24).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARISSA THEIN whose telephone number is (571)272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marissa Thein/
Examiner, Art Unit 3627
March 14, 2010